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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES ATCHISON

Appeal 2008-1345
Application 10/624,320¹
Technology Center 2100

Decided: ² May 18, 2009

Before ALLEN R. MACDONALD, ST. JOHN COURTENAY, III, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

C. THOMAS, *Administrative Patent Judge*.

¹ Application filed July 22, 2003. The real party in interest is BellSouth Intellectual Property Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1-24 mailed June 14, 2006, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

A. INVENTION

Appellant invented a system, method, and computer readable medium for providing a plurality of query criteria for querying an employee database. The employee database is queried by applying respective ones of the query criteria to respective ones of a plurality of employees. A plurality of folders is provided that respectively correspond to respective ones of the plurality of query criteria. A plurality of workbooks is created that contain the results from querying the employee database for respective ones of the plurality of folders. Respective ones of the plurality of workbooks are associated with respective ones of the plurality of employees that have results for respective ones of the plurality of query criteria. (Spec. 17, abstract.)

B. ILLUSTRATIVE CLAIM

The appeal contains claims 1-24. Claims 1, 9, and 17 are independent claims. Claim 1 is illustrative:

1. A method of querying an employee database, comprising:
defining a plurality of query criteria;

querying the employee database by applying respective ones of the query criteria to respective ones of a plurality of employees;

providing a plurality of folders, respective ones of the plurality of folders corresponding to respective ones of the plurality of query criteria; and

creating a plurality of workbooks containing results from the querying the employee database for respective ones of the plurality of folders, respective ones of the plurality of workbooks being associated with respective ones of the plurality of employees that have results for respective ones of the plurality of query criteria corresponding to respective ones of the plurality of folders.

C. REFERENCES

The references relied upon by the Examiner as evidence in rejecting the claims on appeal are as follows:

Szlam	US 6,359,892 B1	Mar. 19, 2002
Rubert	US 6,366,915 B1	Apr. 2, 2002
Handsaker	US 2003/0110191 A1	Jun. 12, 2003
Ramasamy	US 6,944,614 B1	Sep. 13, 2005
		(Filed Nov. 24, 1999)

D. REJECTIONS

The Examiner entered the following rejections³ which are before us for review:

(1) Claims 1-3, 5, 8-11, 13, 16-19, 21, and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Handsaker in view of Szlam;

³ The 35 U.S.C. § 101 rejections were withdrawn by the Examiner (Ans. 3, 10).

(2) Claims 4, 12, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Handsaker in view of Szlam and further in view of Rubert; and

(3) Claims 6, 7, 14, 15, 22, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Handsaker in view of Szlam and further in view of Ramasamy.

II. PROSECUTION HISTORY

Appellant appealed from the Final Rejection and filed an Appeal Brief (App. Br.) on May 2, 2007. The Examiner mailed an Examiner's Answer (Ans.) on June 27, 2007. Appellant filed a Reply Brief (Reply Br.) on August 21, 2007.

III. FINDINGS OF FACT

The following findings of fact (FF) are supported by a preponderance of the evidence.

Handsaker

1. Handsaker discloses “[a] system . . . stores the lists of parameters 110 and results 120, and the types of these parameters 110 and results 120, in a storage module 315 (FIG. 3), for example, a database.” (¶ [0044].)

2. In Handsaker, “[t]he system 300 facilitates these objectives by storing tracking information about workbooks, including their parameters 110, parameter types and dependencies in the storage module 315. In one embodiment, the system 300 stores this information as a workbook information database.” (¶ [0076].)

3. In Handsaker, “a parameter can be a person type parameter. A person type parameter can include attributes such as personal information . . . The personal information can include the . . . Employee No., Work phone, . . . and Date of hire. . . a user can input a value for the attribute Title using a pull-down menu” (¶ [0047]).

4. Handsaker discloses that “the system can automatically generate a user interface to prompt the user for a telesales representative (chosen from a list of all such people known to the system) and a month (based on the months for which the system has data).” (¶ [0051].)

5. Handsaker discloses that “a user can also change parameter values using the pull-down menus 525a and 525b. In response to changing the parameter values and clicking on the “GO” button 530, the system 300 will re-evaluate the virtual workbook 205, selecting a concrete workbook 105’ . . . The concrete workbook is then instantiated and rendered” (¶ [0118]).

6. Handsaker discloses “[t]he first parameterized workbook 105a includes a parameter module 110, a workbook module 115 and a results module 120.” (¶ [0043].)

Szlam

7. Szlam discloses that “[t]he user selects and opens the ‘Main Office’ folder 301 or selects ‘Main Office’ from a pull-down menu” (col. 11, ll. 37-39).

IV. PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int’l Co. v.*

Teleflex, Inc., 550 US 398, 419 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 417.

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)). Therefore, we look to Appellant’s Brief to show error in the proffered *prima facie* case. Only those arguments actually made by Appellant has been considered in this decision. Arguments which Appellant could have made but chose not to make in the Brief have not been considered and are deemed to be waived. See 37 C.F.R. § 41.37(c)(1)(vii).

V. ANALYSIS

Grouping of Claims

In the Brief, Appellant argues claims 1-24 as a group (App. Br. 6-10). For claims 2-24, Appellant repeats the same argument made for claim 1. We will, therefore, treat claims 2-24 as standing or falling with claim 1. See 37 C.F.R. § 41.37(c)(1)(vii). See also *In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991).

The Obviousness Rejection

We now consider the Examiner's rejection of claims 1-24 under 35 U.S.C. § 103(a).

Appellant contends that “the Final Action fails to recognize the distinction recited in the independent claims that a database query is performed first and then workbooks are created that store the results of the database query. Handsaker, by contrast, describes querying workbooks that have previously been created.” (App. Br. 8.)

The Examiner found that “Handsaker states, ‘the concrete workbook is then instantiated and rendered using the changed parameter values.’ Rendering the workbook reads on the claim terminology of ‘creating (generating) a workbook’ because rendering the workbook creates the workbook for display” (Ans. 10).

Issue: Has Appellant shown that the Examiner erred in finding that Handsaker discloses creating a plurality of workbooks containing results from querying the employee database?

The Examiner finds that Handsaker teaches: (1) defining a plurality of query criteria in Fig. 5, items 505 and 515 (Ans. 3); (2) querying a workbook information database in Table 1; and using pull-down menus with options corresponding to respective search criteria as seen in Fig. 5, item 505 and 515 (Ans. 3-4). The Examiner further finds that Szlam teaches using a folder or pull-down menu to accomplish a task (Ans. 4). We endorse and adopt the Examiner's findings.

Specifically, Handsaker discloses a workbook information “database” that stores list of parameters that can include an employee no. and work phone (FF 1-3). Thus, we find that Handsaker’s database is consistent with an “employee database” given that specific employee type data can be stored therein. Further, Handsaker discloses that the user can query the database by selecting a particular person/group and a particular parameter using a drop-down menu (FF 4-5). Szlam discloses that folders can also be used to store/access information (FF 7). Further, Handsaker discloses rendering a concrete workbook in response to changing parameters (i.e., querying) (FF 5), and the concrete workbook includes a results module 120 (FF 6).

Therefore, we find that the disputed features of claim 1 read on the above noted features of Handsaker and Szlam. Specifically, the claimed “creating a plurality of workbooks containing results from querying the employee database” reads on at least Handsaker’s querying of the workbook information database and rendering of a concrete workbook in response to changing parameters.

Motivation to Combine Argument

Appellant further contends that “there would be no motivation to combine the teachings of Handsaker and Szlam because Handsaker contains no disclosure therein about the desirability of organizing the workbooks in separate locations.” (App. Br. 8.)

The Examiner found that “it would have been obvious to . . . modify Handsaker with the above teachings, such that the user interface of fig. 5 of Handsaker uses folders instead of pull-down menus . . . to increase user-

friendliness, since a user may prefer a folder interface to a pull-down menu interface.” (Ans. 4.)

Issue: Has Appellant shown that the Examiner erred in finding that there is motivation to use folders in the system of Handsaker?

In essence, as noted *supra*, Appellant argues that Handsaker fails to disclose the desirability of organizing workbooks in separate location, *i.e.*, in folders. However, as noted *infra* the motivation to modify a teaching need not be found in the references sought to be combined.

The ultimate issue of obviousness is a matter of law that turns on four underlying factual determinations: (1) the scope and content of the prior art, (2) the level of ordinary skill in the art, (3) the differences between the claimed invention and the prior art, and (4) objective indicia of nonobviousness (secondary considerations). *See Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), as reaffirmed by *KSR*, 550 U.S. at 406.

“[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418 (*quoting In re Kahn*, 441 F.3d at 988); *see also DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006) (“The motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself.”); *In re Bozek*, 416 F.2d 1385, 1390 (CCPA 1969) (“Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of

obviousness ‘from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.’”); *In re Hoeschele*, 406 F.2d 1403, 1407 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom ...”) (citations omitted).

Here, we find the Examiner took the specific teaching of “folders” in Szlam and reasonably drew therefrom inferences of a user-friendly system.

Therefore, we do not find that Appellant has shown error in the Examiner’s rejection of illustrative claim 1. Instead, we find the Examiner has set forth a sufficient initial showing of obviousness. Appellant has not shown that the combination of Handsaker and Szlam lacks the above-noted disputed features of claim 1. Therefore, we affirm the rejection of independent claim 1 and of claims 2-24, which fall therewith.

As for the Rubert and Ramasamy references, Appellant merely relies upon the arguments presented for the Handsaker and Szlam references. We note that arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. 37 C.F.R. § 41.37(c)(1)(vii).

VI. CONCLUSIONS

We conclude that Appellant has not shown that the Examiner erred in rejecting claims 1-24.

Thus, claims 1-24 are not patentable.

VII. DECISION

We affirm the Examiner's rejections of claims 1-24 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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